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| APPLICATION NO.  | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO.  | CONFIRMATION NO. |
|--|-------------|----------------------|----------------------|------------------|
| 10/751,565   | 01/05/2004  | Masaaki Ueda         | 17339                | 3667             |
| 23389  | 7590        | 10/13/2005           | EXAMINER             |                  |
| SCULLY SCOTT MURPHY & PRESSER, PC<br>400 GARDEN CITY PLAZA<br>SUITE 300<br>GARDEN CITY, NY 11530 |             |                      | JOHNSON III, HENRY M |                  |
|  |             |                      | ART UNIT             | PAPER NUMBER     |
|  |             |                      | 3739                 |                  |

DATE MAILED: 10/13/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

|                              |                                   |                             |  |
|------------------------------|-----------------------------------|-----------------------------|--|
| <b>Office Action Summary</b> | Application No.<br>10/751,565     | Applicant(s)<br>UEDA ET AL. |  |
|                              | Examiner<br>Henry M. Johnson, III | Art Unit<br>3739            |  |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 05 January 2004.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-31 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-31 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 05 January 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>010504</u> | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Specification***

The disclosure is objected to because of the following informalities: the word incline is used in a manner inconsistent with common English making the meaning unclear. The examiner suggests the use of rotate or pivot to add clarity.

Appropriate correction is required.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-31 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 is not clear in regards to the shaft. It is claimed as part of the moving mechanism in line 7, yet also claimed as supporting the moving mechanism in line 13 and the moving mechanism is able to rotate around the shaft. Further the term "acting around" in lines 20-21 is not clear. It is also unclear how the instrument can be moved around the shaft, as the term around is not well defined with regard to the shaft.

Claims 3, 16, 28 and 31 are indefinite because the claim limitations are dependent on an arbitrary medical instrument that will determine the center of gravity and center of operation. The weight of the instrument, its size and how it is mounted will impact the center of gravity, thus making the claim indefinite.

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Claims 4, 5, 10, 11, 17, 18, 23, 24 and 29 are indefinite as the arms in the claims are not consistent with the arms in the specification. The second arm appears to be claimed as the shaft portion, label 16a, while the specification indicates 16a is the first arm.

Claim 27 is unclear due to the use of the term "the other end portion" for multiple elements. As written, the shaft and rotating member are the same, yet the counterweight is claimed as located on the rotating member when it appears to be on the lower arm of the parallelogram.

Claim 30 is unclear. The term "the moving means having a shaft portion and rotating the supporting means around the shaft portion" in lines 9 and 10 fails to clearly identify the structural relationship. Also the words medical and instrument are run together in line 11.

Claim 30 recites the limitation "the other side" in line 15. There is insufficient antecedent basis for this limitation in the claim.

### ***Claim Objections***

Claims 9, 13, 15, 20, 22 and 26 are objected to under 37 CFR 1.75 as being a substantial duplicate of claim 7. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-6, 8, 10-12, 14, 16-19, 21, 23-25, and 27-31 are rejected under 35

U.S.C. 102(b) as being anticipated by 6,514,239 to Shimmura et al. Shimmura et al. teach a medical instrument holding apparatus with a portion for holding an instrument (Fig. 1, # 14), a support arm (Fig. 1, # 11a), a base support (basal portion, Fig. 1, #s 3 & 4), a shaft coupled to the basal support ( Fig. 1, # 5), the

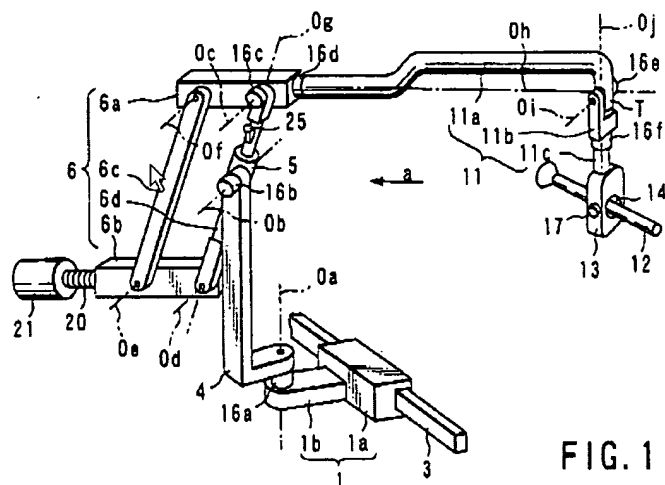


FIG. 1

shaft forming part of a parallelogram moving structure (Fig. 1, # 6) with a counterweight to offset the weight of the support arm and instrument (Fig. 1, # 21). The electromagnetic locks as means for braking their respective movable sections are disclosed (Fig. 1, #s 16a-16f). The instrument holding portion is interpreted is capable of being held by an operator and is coupled to the support arm by rotatable joints (Fig. 1, #s 16e & 16f). The upper portion of the parallelogram is shorter than the lower portion with the counterweight and either of the side arms. The counterweight is adjustable via screw threads (Fig. 1, # 20).

### ***Allowable Subject Matter***

Claim 7 would be allowable if rewritten to overcome the rejection(s) under 35

U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

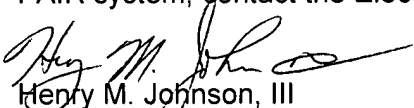
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***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Henry M. Johnson, III whose telephone number is (571) 272-4768. The examiner can normally be reached on Monday through Friday from 6:00 AM to 3:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Linda C. Dvorak can be reached on (571) 272-4764. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Henry M. Johnson, III  
Patent Examiner  
Art Unit 3739